

### **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed October 20, 2006. Reconsideration and allowance of the application and pending claims 1, 3-58, and 60-128 are respectfully requested. No amendments to the claims have been made in this response. Applicants respectfully submit that claims 2 and 59 were canceled in the previous response, and therefore do not address the rejections of claims 2 and 59.

#### **I. Claim Rejections - 35 U.S.C. § 102(e)**

##### **A. Statement of the Rejection**

Claims 104-109, 110, 119, 121, and 127 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Daniels et al.* (“*Daniels*,” U.S. Pat. No. 6,973,669). Applicants respectfully traverse this rejection.

##### **B. Discussion of the Rejection**

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Daniels* reference. Applicants discuss the *Daniels* reference and Applicants’ claims in the following.

## Independent Claims 109 and 121

Claims 109 and 121 recite (with emphasis added):

109. A hyper-linked data caching system comprising:  
a memory; and  
a processor configured with the memory to *cache hyper-linked data in a data structure indexed by time of presentation within a corresponding media content instance.*
121. A hyper-linked data caching method comprising the steps of:  
receiving hyper-linked data corresponding to a media content instance; and  
*maintaining the hyper-linked data in a data structure indexed by time of presentation within the corresponding media content instance.*

Applicants respectfully submit that *Daniels* fails to anticipate at least the above-emphasized claim features.

The Office Action (page 2, emphasis added) alleges that *Daniels* discloses:

a processor (24) configured with the memory (controlling the system; column 15, lines 58-63) to cache hyper-linked data (column 24, lines 13-24) in a data structure indexed by the time of presentation with a corresponding media content instance (*received and stored in order*; column 4, lines 23-38 and column 24, lines 13-34).

Applicants respectfully disagree.

*Daniels* (col. 4, ln. 32-35 and col. 24, ln. 13-16) describes the receipt and saving of data as:

Once received, this information can be stored on a conventional data storage device, such as a hard drive, RAM, or the like, so that it is retrievable by a viewer at any time.

A number of such hyper linked pages can be downloaded and cached by the inventive multi-featured multi-media appliance 1000 during the reception of the television program. . .

It appears that *Daniels* discloses merely receiving and storing hyperlinked and web page data, and does not disclose, teach, or suggest the feature of caching ***hyper-linked data in a data structure indexed by time of presentation within a corresponding media content instance***. In fact, *Daniels* does not disclose any type of indexing data in a data structure. Further, Applicants have not found anything in the *Daniels* reference that suggests that the cached data is “received and stored in order” as alleged in the Office Action.

Additionally, the Office Action alleges the following on page 35, section 10b:

In response to the applicant’s arguments in regards to claims 109 and 121, *Daniels* specifically discloses wherein received hyperlink data is stored in local storage (column 24, lines 11-37). Stored data clearly meets the claim limitation of a “data structure”, as the claim provides no specific limitation as to the *type* of structure.

Furthermore, *Daniels* specifically discloses wherein the pages are downloaded and cached during reception of the program (column 24, lines 11-21) to provide information about the current section of the program (column 23, lines 35-50).

Thus the data is indexed by time of presentation, as the data is downloaded and stored as they are received, during the normal presentation of the program.

Applicants respectfully disagree. As discussed above, the claimed data structure is ***indexed by time of presentation within a corresponding media content instance***. *Daniels* fails to disclose, teach, or suggest this feature.

Due to the shortcomings of the *Daniels* reference described in the foregoing, Applicants respectfully submit that *Daniels* does not anticipate Applicants’ claims. Therefore, Applicants respectfully request that the rejection of claims 109 and 121 be withdrawn.

Because independent claims 109 and 121 are allowable over *Daniels*, dependent claims 110, 119 and 127 are allowable as a matter of law for at least the reason that the

dependent claims 110, 119 and 127 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

#### **Independent Claim 104**

Claim 104 recites (with emphasis added):

104. A media client device comprising:  
a memory;  
a plurality of tuners; and  
*a processor configured with the memory to transition from supporting playback of media content from a virtual file system to a combination of the virtual file system and a local file system depending on the availability of the local file system.*

Applicants respectfully submit that *Daniels* fails to anticipate at least the above-emphasized claim features. The Office Action (page 3, emphasis added) alleges that *Daniels* discloses:

a processor configured with the memory (controlling the system; column 15, lines 58-63) to transition from supporting playback of media content from a virtual file system (column 24, lines 11-24 and column 23, lines 39-50) to a combination of the virtual file system and a local file system depending on the availability of the local file system (displaying remote Internet web pages and local stored pages; column 24, lines 11-24 and column 23, lines 39-50).

Applicants respectfully disagree.

*Daniels* (col. 23, ln. 39-42) describes the receipt and saving of data as:

This Internet address or blanking interval information can be included in the vertical blanking interval of the video signal that carries the commercial, and stored in a RAM or other memory device.

It appears, arguendo, that *Daniels* discloses that the internet address or blanking interval information can be stored in RAM or another memory device. This is not the same as the claimed feature of transitioning “from supporting playback of *media content* from a

virtual file system to a combination of the virtual file system and a local file system depending on the availability of the local file system.”

Further, assuming *arguendo* that *Daniels* includes saving media content, the features of transitioning “from supporting playback of media content from a virtual file system to a combination of the virtual file system and a local file system depending on the availability of the local file system” are not disclosed, taught, or suggested because *Daniels* fails to disclose any transition of playback between a virtual file system and a combination of the virtual file system and a local file system ***depending on the availability of the local file system***.

Additionally, the Office Action alleges on page 35, section 10a the following:

In response to the applicant’s arguments in regards to claim 104, *Daniels* specifically discloses utilizing locally stored web pages when they are available in the local file system (column 24, lines 11-37). If the user selects a web-page which is unavailable locally, the system will transition from local storage to other web pages which are not stored locally (column 24, lines 11-37), thus meeting the claim limitations.

Applicants respectfully disagree. *Daniels* column 24, lines 11-37 recites:

FIG. 10 illustrates the information that might be displayed when the user activates one of the hyperlinks included with an interval page. A number of such hyper linked pages can be downloaded and cached by the inventive multi-featured multi-media appliance 1000 during the reception of the television program, the data can be streamed in the background carried in the VBI of the television signal that includes the viewed television program, via and Internet net, or by simultaneously tuning into a data channel carried along with the television channels supplied by the television system provider. As illustrated, some of the hyperlinks can also be linked to an Internet site, such as a world wide web site that includes more information relevant to the product advertised in the television commercial.

Applicants respectfully submit that there is nothing in the above citation or anywhere else in *Daniels* that discloses, teaches, or suggests the claimed features of transitioning ***from supporting playback of media content from a virtual file system to a combination of the***

*virtual file system and a local file system depending on the availability of the local file system.* It appears that *Daniels* discloses the downloading and caching of hyper linked pages and that “some of the hyperlinks can also be linked to an Internet site” (column 24, lines 21-22). However, these disclosures clearly do not disclose, teach, or suggest the above emphasized claim features.

Thus, due to the shortcomings of the *Daniels* reference described in the foregoing, Applicants respectfully submit that *Daniels* does not disclose, teach, or suggest Applicants’ claim. Therefore, Applicants respectfully request that the rejection of claim 104 be withdrawn. Because independent claim 104 is allowable over *Daniels*, dependent claims 105-108 are allowable as a matter of law.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Rejection of Claims 1-14, 16-20, 58-63, 69-75 and 77-81**

Claims 1-14, 16-20, 58-63, 69-75 and 77-81 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Payton* (“*Payton*,” U.S. Pat. No. 5,790,935) in view of *Norwood et al.* (“*Norwood*,” U.S. Pat. No. 5,983,316). Claims 1, 4, 15, 21-36, 38, 48, 49, 58-59, 64-68, 76, 82-92, 94, 102-103 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniels* in view of *Norwood*. Claims 1, 4, 36, 37, 39-47, 58, 59, 92, 93 and 95-101 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Schein et al.* (“*Schein*,” U.S. Pat. 6,002,394) in view of *Norwood*. Claims 111-118, 120, 122-126 and 128 have been rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Daniels* in view of *Shimoji et al.* (“*Shimoji*,” U.S. Pat. 6,757,911). Claims 50-57 have

been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniels* and *Norwood* and in further view of *Shimoji*. Applicants respectfully traverse these rejections.

## **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

## **Independent Claims 1 and 58**

1. A dual mode file system in a subscriber network television system, comprising:
  - a digital home communication terminal (DHCT) comprising:
    - a memory with logic; and
    - a processor configured with the logic to determine whether a local file system is coupled to the DHCT, *the processor further configured with the logic to, responsive to determining that the local file system is not coupled to the DHCT, use remote data from a virtual file system to support the processor*, the processor further configured with the logic to, responsive to determining that the local file system is coupled to the DHCT, use local data stored in the local file system and the remote data from the virtual file system to support the processor.

58. A dual mode file method in a subscriber network television system comprising the steps of:

determining whether a local file system is coupled to a digital home communication terminal (DHCT);

***responsive to determining that the local file system is not coupled to the DHCT, using remote data from a virtual file system to support a processor in the DHCT;*** and

responsive to determining that the local file system is coupled to the DHCT, using local data stored in the local file system and the remote data from the virtual file system to support the processor.

Applicants respectfully submit that *Payton* in view of *Norwood* fails to disclose, teach, or suggest at least the above-emphasized claim features. In particular, Applicants respectfully submit that *Norwood* fails to remedy the deficiencies of *Payton*.

The Office Action (page 6, emphasis added) alleges that:

... *Norwood* discloses a computer storage system (Fig. 1) wherein a disk monitor will determine whether local file systems (disk drives; column 2, lines 38-48) are currently coupled and available for use by the system (column 2, lines 28-38 and column 5, lines 22-42) to allow the system to dynamically determine which resources are currently available (column 2, line 28-column 3, line 14) for the typical benefit of allowing the computer system to dynamically determine status changes in available storage resources ***and operate accordingly***; (see Abstract and column 2, line 28-column 3, line 14 and column 1, lines 8-31).

Applicants respectfully disagree.

*Norwood* (column 2, lines 28 – 63, emphasis added) describes the function of the resource monitor:

For example, the resource monitor monitors which physical volumes in a storage pool have available physical links by periodically sending a SCSI inquiry to each physical volume in the storage pool to determine whether a physical link to each physical volume is available.

Likewise, the resource monitor monitors a number of copies of data within each logical volume of storage by first ascertaining whether logical volumes containing the copies of data are active. When the resource monitor detects that the logical volume is not active, the resource monitor indicates that there are no available copies of data within the logical volume. When the resource



monitor determines that the logical volume is active, the resource monitor counts a number of "good" (i.e., not stale or missing) copies for each logical extent within the logical volume. . .

. . . The resource monitor *indicates* that there is not available a copy of all data within the logical volume group when there are no physical links to physical volumes for the logical volume group that are up.

Assuming arguendo that the resource monitor in *Norwood* dynamically determines status changes in available storage resources, *Norwood* still fails to disclose, teach, or suggest the claimed feature of ***"responsive to determining that the local file system is not coupled to the DHCT, use remote data from a virtual file system to support the processor."*** *Norwood* appears to merely "[*indicate*]" that there is not available a copy of all data within the logical volume group" (*Norwood*, column 2, lines 60-61), and not ***"use remote data from a virtual file system to support the processor"*** as claimed. There is simply no disclosure of these features in the description of the resource monitor in the *Norwood* citation above, or anywhere else in *Norwood* or *Payton*. Therefore, for at least the above reasons, Applicants respectfully request that the rejection to independent claims 1 and 58 be withdrawn.

Because independent claims 1 and 58 are allowable over *Payton* in view of *Norwood*, dependent claims 3-14, 16-20, 60-63, 69-75, and 77-81 are allowable as a matter of law.

With regard to the use of *Daniels* and *Norwood* to reject independent claims 1 and 58, Applicants respectfully submit that *Norwood* fails to remedy the deficiencies of *Daniels*. That is *Norwood* does not disclose, teach, or suggest the above emphasized features as explained above. Thus, Applicants respectfully submit that *Daniels* in view of *Norwood* fails to disclose, teach, or suggest at least the above-emphasized claim features, and

for at least the above reasons, Applicants respectfully request that the rejection to independent claims 1 and 58 be withdrawn.

Because independent claims 1 and 58 are allowable over *Daniels* in view of *Norwood*, dependent claims 4, 15, 21-36, 38, 48-49, 64-68, 76, 82-92, 94, and 102-103 are allowable as a matter of law.

Additionally, with regard to the use of *Schein* and *Norwood*, Applicants respectfully submit that *Norwood* fails to remedy the deficiencies of *Schein* for similar reasons presented above. Thus, Applicants respectfully submit that *Schein* in view of *Norwood* fails to disclose, teach, or suggest at least the above-emphasized claim features, and for at least the above reasons, Applicants respectfully request that the rejection to independent claims 1 and 58 be withdrawn.

Because independent claims 1 and 58 are allowable over *Schein* in view of *Norwood*, dependent claims 4, 36-37, 39-47, 92-93, and 95-101 are allowable as a matter of law.

#### **Dependent Claims 111-118, 120, 122-126, and 128**

Applicants submit that as provided above, independent claims 109 and 121 are allowable over *Daniels*. Applicants respectfully submit that *Shimoji* does not remedy the above-described deficiencies of *Daniels*. Thus, for at least the reasons that dependent claims 111-118, 120, 122-126, and 128 incorporate the features of respective allowable claims 109 and 121, dependent claims 111-118, 120, 122-126, and 128 are allowable as a matter of law.

### **Dependent Claims 50-57**

Applicants submit that as provided above, independent claim 1 is allowable over *Daniels* in view of *Norwood*. Applicants respectfully submit that *Shimoji* does not remedy the above-described deficiencies of *Daniels* in view of *Norwood*. Thus, for at least the reasons that dependent claims 50-57 incorporate the features of respective allowable claim 1, dependent claims 50-57 are allowable as a matter of law.

### **III. Official Notice**

The Office Action has made the following allegations of Official Notice (location in the Office Action and claim relevance noted in parenthesis):

(Page 21, pertaining to claims 26 and 84) The examiner takes Official Notice that it was notoriously well known in the art at the time of invention by applicant for a television receiver to utilize both an analog and digital transmission channel, such as when receiving both off-air television and digital satellite, for the typical benefit of providing a viewer with an increased amount of information and content by allowing access to both digital and analog content providers and connections.

(Page 36, pertaining to claims 5-8 and 69-72) In response to applicant's traversal of the Official Notices presented for claims 5-8 and 69-72, it is noted that the current rejections provide *Norwood* as specifically disclosing all of these claimed features.

(Page 36, pertaining to claims 26 and 84) In response to applicant's traversal of the Official Notices presented for claims 26 and 84, applicant is directed to *Rasson et al.* (6,137,549) and *Basawapatna et al.* (6,598,231) which disclose that it was well known to receive both analog and digital channels.

Applicants respectfully traverse these allegations of well-known or Official Notice and submit that the subject matter pertaining to these claims should not be considered well-known. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances

should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner’s assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a finding of well known art is improper at least given the added complexity associated with such features as described in claims 5-8, 26, 84, and 69-72.

Additionally, Applicants respectfully submit that in regards to claims 5-8 and 69-72, *Norwood* fails to disclose that the claimed features are well known for similar reasons as discussed in the response to the rejection of the claims above.

Further, in regards to claims 26 and 84, neither *Rasson* nor *Basawapatna* disclose that it was well known to receive both analog and digital channels. *Rasson* appears to describe distributing television program guide data not including media content. *Basawapatna* appears to describe a telecommunications system not a digital subscriber television network. Neither of these references demonstrate that it was well known to receive both analog and digital channels.

Accordingly, Applicants traverse the assertions with regard to well-known use.

Because of this traversal, the Office must support its findings with evidence, or withdraw the well-known determination.

#### **IV. Inherency**

On page 5 of the Office Action, inherency is alleged with regard to claim 1, as reproduced below:

...a processor configured with the logic (inherently present to control the local server, 28; column 6, lines 1-50) to use local data stored in the local file system. . .

Applicants respectfully disagree. The Examiner alleges that a processor configured with logic must inherently control the local server. Applicants respectfully submit that the claimed logic is not inherently present in the local server since other means may be utilized to control the processor.

According to well-established Federal case law, “[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation.” *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006). Thus, Applicants respectfully traverse the allegation of inherency with respect to the above-emphasized claim features in the rejection of claim 1 and respectfully request that the rejection be withdrawn for these reasons in addition to reasons presented above in Section II of the response.

### **CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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